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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/773,953	02/01/2001	Hiroshi Ono	P/647-137	9136

7590

11/05/2004

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EXAMINER

NGUYEN, DUC M

ART UNIT

PAPER NUMBER

2685

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 09/773,953	Applicant(s) ONO, HIROSHI	
	Examiner Duc M. Nguyen	Art Unit 2685	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached "Response to Arguments".
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-6,9-16 and 19-24.

Claim(s) withdrawn from consideration: 17 and 18.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Response to Arguments

1. Applicant's arguments filed 9/17/04 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the limitation of "content data converted into a data format that the radio terminal can reconstruct", recall that **Shimoda** discloses a cellular phone (read on "radio terminal") with enhanced capabilities through the use of a computer (read on "external server"), wherein one of the enhanced capabilities includes data **encryption** which may not be feasibly implemented in cellular phones of relatively small size (see Abstract and **col. 1, lines 55-65** and **col. 3, lines 25-35**). Here, since a data encryption is provided by the computer, it is clear that when the cellular phone receives an encrypted data message, the encrypted data would be transferred to the computer for decrypting and transfer back to the cellular phone for utilizations (i.e, display the message in a normal (decrypted) format). Therefore, Applicant argues that **Shimoda** neither taught nor suggested the external server transmits "content data converted into a data format that the radio terminal can reconstruct" is not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves **or** in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since there is some teaching, suggestion, or motivation to do so found either in the references themselves (Applicant's admitted prior art (AAPA) regarding mobile terminals receiving encrypted data over the Internet), or in the knowledge generally available to one of ordinary skill in the art (the mobile phone that can transmit/receive encrypted data or have the Web browser capability), it would have been obvious to one skill in the art to incorporate the above teaching of AAPA to Shimoda or modify Shimoda for providing Internet capability acquisition to the cellular phone as well, so that the mobile phone can transmit/receive encrypted information to/from Internet, thereby providing a data conversion by the computer as claimed, for utilizing advantages of the Internet network such as low cost, global information available in real-time.

Therefore, by simply providing Internet capability acquisition to the cellular phone in Shimoda's reference, the claimed limitations are made obvious by Shimoda for providing enhanced capabilities to a mobile phone without the need of buying a large, complex and expensive mobile device.

For foregoing reasons, the examiner believes that the pending claims are not allowable over the cited prior art.

2. Any response to this action should be mailed to:

Box A.F.

Commissioner of Patent and Trademarks

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Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or
DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from
the examiner should be directed to Duc M. Nguyen whose telephone number is
703-306-4531. The examiner can normally be reached on Monday-Thursday
(9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the
examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax
phone number for the organization where this application or proceeding is
assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application
or proceeding should be directed to the receptionist whose telephone number is
703-305-3900.

Duc M. Nguyen
Oct 21, 2004

